

REMARKS

The Final Office Action of October 9, 2009 has been considered by the Applicant. No claims are added, amended, or cancelled. Claims 43-48 and 50 are pending.

Claims 43-48 and 50 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Arsem (U.S. Patent No. 2,472,361) and Marks (U.S. Patent No. 2,817,621) in view of Katzen (U.S. Patent No. 4,369,199). Applicant traverses the rejection.

Upon review, Applicant may have misunderstood the rejection presented in the previous Office Action. The rejection is labeled as being over Arsem and Marks in view of Katzen. This could be construed as two rejections: Arsem in view of Katzen and Marks in view of Katzen. However, based on the Examiner's comments, Applicants respond in the belief that the Examiner is applying one 103(a) rejection that combines all three references.

Applicant previously argued that the recitation of "controlling Darkling beetles" in the preamble should be given patentable weight. The Examiner replied that the limitation was not given patentable weight because allegedly it merely recites an additional benefit of applying TCM and because there is no requirement that Darkling beetles actually be present in the habitat being treated.

Applicant respectfully disagrees. "Controlling Darkling beetles" is not merely a statement of intended use, but rather a statement that gives life and meaning. MPEP § 2111.02(II). "[R]eliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation." MPEP § 2111.02(II); *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d at 808-09, 62 USPQ2d at 1785. This test is met in this application, wherein the phrase "controlling Darkling beetles" has been the basis for overcoming both § 112 and § 102 rejections. Thus, the preamble language constitutes a claim limitation and must be given patentable weight.

Applicants also submit that there is no motivation to apply the trichloromelamine (TCM) based on the references. In particular, it appears the Examiner's motivation is to use the composition of TCM and citric acid disclosed by Marks to treat animal bedding as taught by Katzen. However, Katzen only requires the acid disclosed by Marks, and

makes no statement regarding the need to include TCM as well. In other words, Applicants believe the Examiner is still applying improper hindsight reasoning here. To the extent the Examiner is suggesting that Katzen would necessarily look to Marks and decide that adding TCM would also be beneficial, there is no disclosure in Katzen of any benefit.

Applicant requests withdrawal of the § 103(a) rejection.

CONCLUSION

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 43-48 and 50) are now in condition for allowance.

Respectfully submitted,

Fay Sharpe LLP

12/8/09
Date

Richard M. Klein
Richard M. Klein, Reg. No. 33,000
The Halle Building, 5th Floor
1228 Euclid Avenue
Cleveland, Ohio 44115-1843
216.363.9000

CERTIFICATE OF MAILING OR TRANSMISSION	
I hereby certify that this correspondence (and any item referred to herein as being attached or enclosed) is (are) being <input type="checkbox"/> deposited with the United States Postal Service as First Class Mail, addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below. <input checked="" type="checkbox"/> transmitted to the USPTO by electronic transmission via EFS-Web on the date indicated below.	
Express Mail Label No.:	Signature: <u>G. Sonntag</u>
Date: <u>12/9/09</u>	Name: <u>G. SONNATAG</u>

N:\HSCH\200007\mdk0000196V001.docx